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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/790,359

03/01/2004

Caleb C. Rutan

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SCHOX PLC
209 N. MAIN STREET #200
ANN ARBOR, MI 48104

EXAMINER

WEST, THOMAS C

ART UNIT

PAPER NUMBER

3621

MAIL DATE

DELIVERY MODE

01/25/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/790,359	Applicant(s) RUTAN ET AL.	
	Examiner THOMAS WEST	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3-1-04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5, 7, 8, 12, 13, 16, 20, 22, 23, 26, 27, 30, 34, 35, 38, 41, 42, 45, 47, 48, 49, 52, 55 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3-21-05</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims pending in the application are 1,2,5,7,8,12,13,16,20,22,23,26,27,30,34,35,38,41,42,45,47-49,52 and 55.

DETAILED ACTION

Status of Claims

1. This action is in reply to the US Application filed March 1, 2004.
2. Claims 1, 2, 5, 7, 8, 12, 13, 16, 20, 22, 23, 26, 27, 30, 34, 35, 38, 41, 42, 45, 47, 48, 49, 52, 55 are currently pending and have been examined.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 5, 7, 8, 12, 20, 22, 23, 26, 27, 30, 34, 38, 41, 42, 45, 47, 48, 52, 55 are rejected under U.S.C. 102(b) as being unpatentable over Inoue, U.S. Patent Application No. 2003/0028622.

Claims 1, 2, 7, 26, 27, 41, 42, 47:

Inoue, as shown, discloses the following limitations:

- requesting a license from the server, transferring a first license to the first client, and allowing a first set of licensed actions with the electronic file based on the first license (see at least paragraph 6)

- upon the occurrence of an event, requesting a license from the server and modifying the first license (see at least paragraph 58)
- allowing an initial set of permissible actions with the electronic file regardless of a connection between the first client and the server, wherein the first set of licensed actions is less restrictive than the initial set of permissible actions (see at least paragraph 117)
- transferring a second license to the second client that allows a second set of licensed actions with the electronic file (see at least paragraph 58)

Claims 5, 12, 22, 45, 48:

Inoue, as shown, discloses the following limitations:

- allowing an initial set of permissible actions with the electronic file regardless of a connection between the first client and the server, wherein the first set of licensed actions is less restrictive than the initial set of permissible action (see at least paragraphs 4, 21)
- allowing a modified set of licensed actions regardless of a connection between the first client and the server (see at least paragraph 115)

Claims 20, 34, 52, 55:

Inoue, as shown, discloses the following limitations:

- further includes transferring a modified license to the first client and, upon receipt of the modified license from the server,

allowing a modified set of licensed actions with the electronic file wherein the modified set of licensed actions is more restrictive than the first set of licensed actions (see at least paragraphs 4, 115)

Claims 8, 23, 30, 38:

Inoue, as shown, discloses the following limitations:

- receiving a license request from the second client and transferring a second license to the second client that allows a second set of licensed actions with the electronic file, and generating a second license based on an attribute of the second client, wherein the second set of licensed actions is substantially similar to the first set of licensed actions. (see at least paragraphs 38, 115)

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3621

6. Claims 13, 16, 35, 49 are rejected under U.S.C. 103(a) as being unpatentable over Inoue, U.S. Patent Application No. 2003/0028622 in view of Barber, US Patent No. 5,390,297.

Claims 13, 16, 35, 49:

Inoue discloses the limitations as shown above. Inoue does not directly disclose a dummy file or empty license, but Barber teaches:

- the event is a transfer of the file from the first client to the second client, requesting a dummy file upon the transfer of the file from the first client to the second client, and receiving the dummy file and requesting a license from the server upon the receipt of the dummy file. (see at least column 11, lines 4-12)
- receiving an empty license from the server and, based on the empty license, allowing an initial set of permissible actions with the electronic file, and allowing an initial set of permissible actions regardless of a connection between the first client and the server, wherein the initial set of permissible actions is more restrictive than the first set of licensed actions (see at least paragraph column 11, lines 4-12)

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Inoue to include the dummy file and empty license of Barber, since this aids in insuring the erasure/deletion of the original license file, preserving the security of issued licenses.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas West whose telephone number is 571-270-1236. The examiner can normally be reached on M-R 7:30am - 5pm EST, ALT Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thomas West
Patent Examiner
Art Unit 3621
January 17, 2008

/Andrew J Fischer/
Supervisory Patent Examiner, Art Unit 3621